

REMARKS

Entry of the foregoing and reconsideration of the subject application are respectfully requested in light of the amendments above and the comments which follow.

As correctly noted in the Office Action Summary, claims 1-10 were pending. By the present response, claims 1, 3-5 and 10 have been amended and claims 31-37 have been added. Claims 3-5 have been amended merely to correct a grammatical error by placement of a comma into the claim. Thus, upon entry of the present response, claims 1-10 and 31-37 remain pending and await further consideration on the merits.

Support for the foregoing amendments can be found, for example, in at least the following locations in the original disclosure: the original claims and the specification, paragraph [0022].

CLAIM REJECTIONS UNDER 35 U.S.C. §103

Claims 1-7 and 9-10 stand rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 5,537,905 to Zimmer et al. (hereafter "*Zimmer et al.*") on the grounds set forth in paragraph 3 of the Official Action. Claim 8 stands rejected under 35 U.S.C. §103(a) as being unpatentable over *Zimmer et al.* in view of U.S. Patent No. 6,464,121 to Reijnders (hereafter "*Reijnders*") on the grounds set forth in paragraph 4 of the Official Action. These rejections should be withdrawn because a prima facie case of obviousness has not been established.

To establish a prima facie case of obviousness, three criteria must be met including establishing a suggestion or motivation to modify the reference or to

combine the teachings, establishing a reasonable expectation of success for the proposed modification or combination, and showing that the references teach or suggest all of the claimed features. See, MPEP §2142-43. Here, the rejection is deficient in that the reference has not been shown to teach or suggest all of the claimed features nor has there been shown any motivation to modify the references.

Zimmer et al. discloses a nicked cutting rule with a shank portion 2, a cutting portion 4 with v-shaped cutting edge 6 and side surfaces 5a and 5b, and intermediate portion 9 interconnecting the shank 2 and cutting portions 4 (see col. 3, lines 32-47 and Fig. 2). The cutting portion 4 has a plurality of teeth 7 separated by notches or nicks 8 (col. 3, lines 43-45). *Zimmer et al.* discloses a thickness of the rule at col. 4, lines 16-18 and a hardness of the rule at col. 4, lines 48-54. Further, *Zimmer et al.* discloses that the cutting portion 4 with the cutting edge 6 is ground (col. 4, lines 44-46).

Independent claims 1 and 10 disclose, among other features, that at least one of the two cutting edge portion surfaces and the two intermediate portion surfaces are shaved.

As understood by one of ordinary skill in the art, a ground surface, e.g., as disclosed in *Zimmer et al.*, is different from a shaved surface, e.g., as claimed. Several examples of the differences between a shaved surface and a ground surface include:

- a ground surface has grinding scratches pointing to the edge and the shaved scratches going along the bevel and edge.
- grinding creates deeper scratches in the ground edge than found in the shaved edge.
- the bevel roughness of a shaved edge is in general smoother and has a lower Ra value compared to a ground edge.

- a ground edge has sharper edges which is a combination of creating a smaller edge radius as well as micro burrs left from the grinding operation
- a shaved edge is more advantageous compared to a ground edge because the shaving technique gives a much closer height tolerance in the cutting rule compared to the grinding technique and this improves and makes easier die operations in the cutting press at the converter

For visual comparison and to further illustrate the differences between a shaved edge and a ground edge, magnified images of the edge finish of a shaved edge and of a ground edge are attached.

From the above, it is respectfully asserted that one of ordinary skill differentiates between a ground surface and a shaved surface. Further, the disclosure of a ground surface in the reference does not teach or suggest a shaved surface as claimed, as the two types of surfaces are distinct in the art.

Therefore, it is respectfully asserted that the claimed shaved surface distinguishes over the disclosure in *Zimmer et al.* because *Zimmer et al.* does not disclose, teach or suggest at least this feature of the claim.

Further, there has been no motivation shown to cause one of ordinary skill to modify the disclosure in *Zimmer et al.* to arrive at the present claims. *Zimmer et al.* has no disclosure of shaving the surface that would lead one to modify the disclosed grounding. *Reijnders*, cited for the proposition of providing different distances between succeeding notches, also has no disclosure, teaching or suggestion to shave the surfaces. Thus, the cited references, either alone or in combination, do not contribute to establish obviousness of the present claims.

For at least the above noted reasons, the rejections should be withdrawn.

CONCLUSION

From the foregoing, further and favorable action in the form of a Notice of Allowance is earnestly solicited. Should the Examiner feel that any issues remain, it is requested that the undersigned be contacted so that any such issues may be adequately addressed and prosecution of the instant application expedited.

Respectfully submitted,

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